



31 AUG 2006

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In re Application of	:	
MILLAR, et al.	:	DECISION ON PETITION
Serial No.: 10/543,017	:	
PCT No.: PCT/AU04/00083	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 23 January 2004	:	
Priority Date: 24 January 2003	:	
Atty Docket No.: ALAR18.001APC	:	
For: ASSAY FOR DETECTING METHYLATION	:	
CHANGES IN NUCLEIC ACIDS USING AN	:	
INTERCALATING NUCLEIC ACID	:	

This decision is in response to applicant's "PETITION UNDER 37 C.F.R. 1.47(a)" filed 24 July 2006 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of joint inventor George Miklos.

BACKGROUND

On 23 January 2004, applicant filed international application PCT/AU04/00083, which claimed priority of an earlier application filed 24 January 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 August 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 July 2005.

On 22 July 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 23 February 2006, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 24 July 2006, applicant filed the present petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor George Miklos accompanied by a petition for a three-month extension of time and payment of the appropriate extension of time fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1, 3 and 4.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." 409.03(d) also states that:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

In the present case, applicant has provided a declaration from Dr. Trevor J. Davies detailing his attempts to obtain the signature of inventor Miklos. Dr. Davies states that the inventor refused to sign the declaration during a meeting on May 25, 2006 and again during a telephone conversation on June 28, 2006. However, applicant has not included any evidence that would show that Dr. Miklos knew specifically which invention was being discussed when he refused to sign the declaration. In a situation such as this where applicant is seeking to proceed on the basis of an oral refusal combined with non-receipt of a complete set of the application papers, applicant must provide a showing that the inventor was aware of the particulars of what he was being asked to sign; either through the mailing of the papers to the inventor or through a statement from Dr. Davies that shows that it was clear at the meeting of May 25, 2006 that Dr. Miklos was aware of the particulars of the application in question, i.e. that there was a complete set of application papers available for his review.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'D. Putonen', written in a cursive style.

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